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| 10/594,559 | 01/19/2007 | Juan Carlos Lopez Calvet | 1380-0231PUS1 | 3554 |
| 2292 7590 10/27/2010 BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747 | | | | |
| EXAMINER | | | | |
| GAO, JING | | | | |
| ART UNIT | | PAPER NUMBER | | |
| 2617 | | | | |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary

Application No.

10/594,559

Applicant(s)

CALVET ET AL.

Examiner

Jing (Kristen) Gao

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 September 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/5508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

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DETAILED ACTION

1. In view of the appeal brief filed on 08/02/2010, PROSECUTION IS HEREBY REOPENED. A new ground of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

/George Eng/

Supervisory Patent Examiner, Art Unit 2617.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1-6, 8 and 11-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Ritter et al. (AU Appl. No. 199730224 B2, Pat. No. 736350), hereinafter Ritter.

Regarding to Claim 1, Ritter teaches *subscriber identity module for a mobile communication terminal* (Figures 1 and 2; SIM for portable phone), *comprising a processing device* (Figure 2 and Page

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1 Lines 22-26 and Page 6 Lines 1-16; microcontroller and data processing zone), *a memory device* (Figure 2 and Page 1 Lines 22-26 and Page 6 Lines 1-16; memory zone), *an I/O device* (Figure 2 and Page 1 Lines 22-26 and Page 6 Lines 1-16; contact area for communication between SIM and mobile station) *and a wireless communication device which is connected to an antenna included in said subscriber identity module* (Figure 2 and Page 6 Lines 17-33; the SIM has a integrated circuit responsible for the direct communication with an external device via coil or antenna),

wherein said wireless communication device is an interrogatable transponder (Figure 2 and Page 6 Lines 17-33; the SIM has a integrated circuit responsible for the direct communication with an external device via coil or antenna), *operatively controllable by said processing device and arranged to be operatively enabled or disabled, and controlled by a signal provided by the mobile communication terminal via said I/O device* (Figure 2 and Page 6 Lines 1-16 and Page 9 Lines 5-11; the mobile station sends instruction from keyboard to chipcard via contact area, and chipcard then communicates the instruction to external device via coil or antenna).

Regarding to Claim 2, Ritter teaches all of the limitations of Claim 1, as described above.

Further, Ritter teaches *wherein said signal is provided by a user interface in the mobile terminal* (Figure 2 and Page 6 Lines 1-16 and Page 9 Lines 5-11; the mobile station sends instruction from keyboard to chipcard via contact area).

Regarding to Claim 3, Ritter teaches all of the limitations of Claim 1, as described above.

Further, Ritter teaches *said signal is provided by a mobile communication operator* (Figure 2 and Page 6 Lines 1-16, Page 9 Lines 5-11 and Page 12 Lines 8-12; chipcard receives instruction through conventional communication via conventional mobile network).

Regarding to Claim 4, Ritter teaches all of the limitations of Claim 1, as described above.

Further, Ritter teaches *said interrogatable transponder comprises identification data contained in a memory, said identification data being configurable by said processing device* (Page 6 Lines 1-16 and

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Page 11 Lines 20-29; the chipcard can be loaded with an electronic key stored in the memory under the control of microcontroller and processor).

Regarding to Claim 5, Ritter teaches all of the limitations of Claim 4, as described above.

Further, Ritter teaches said identification data is provided by the mobile communication terminal via said I/O device (Page 2 Lines 23-28, Page 6 Lines 1-16, Page 9 Lines 5-11 and Page 11 Lines 20-29; the chipcard can be loaded with an electronic key stored in the memory from the keyboard via contact area on the chipcard).

Regarding to Claim 6, Ritter teaches all of the limitations of Claim 5, as described above.

Further, Ritter teaches *said identification data is provided by a mobile communication operator* (Page 6 Lines 1-16, Page 11 Lines 20-29 and Page 12 Lines 8-12; the chipcard can be loaded with an electronic key stored in the memory through conventional communication via conventional mobile network).

Regarding to Claim 8, Ritter teaches all of the limitations of one of the Claims 1-7, as described above. Further, Ritter teaches *said transponder is an active RFID transponder* (Page 7 Lines 28-32 and Page 8 Lines 1-5; the chipcard may be powered by a backup battery fed by mobile station).

Regarding to Claim 11, Ritter teaches all of the limitations of Claim 1, as described above.

Further, Ritter teaches *wherein said subscriber identity module is used as an authentication token* (Page 11 Lines 20-29; the chipcard can be loaded with an electronic key to authenticate the user).

Regarding to Claim 12, Ritter teaches all of the limitations of Claim 1, as described above.

Further, Ritter teaches *wherein said subscriber identity module is used as an authentication token for an access control system* (Page 11 Lines 20-29; the chipcard can be loaded with an electronic key to authenticate the user to access control device and system).

Regarding to Claim 13, Ritter teaches all of the limitations of Claim 1, as described above.

Further, Ritter teaches wherein *said subscriber identity module is used as an authentication token for a mobile commerce system* (Page 10 Lines 9-24 and Page 11 Lines 20-29; direct communication between chipcard and external device with the aid of coil or antenna can make loading money to and from chipcard possible).

Regarding to Claim 14, Ritter teaches all of the limitations of Claim 1, as described above.

Further, Ritter teaches *mobile communication terminal, comprising a subscriber identity module according to claim 1* (Figure 1 and Page 5 Lines 22-29; mobile station with chipcard).

Regarding to Claim 15, Ritter teaches all of the limitations of Claim 1, as described above.

Further, Ritter teaches *a mobile communication terminal, comprising a subscriber identity module, wherein said mobile communication terminal is used as an authentication token* (Page 11 Lines 20-29; the chipcard in a mobile station can be loaded with an electronic key to authenticate the user).

Regarding to Claim 16, Ritter teaches all of the limitations of Claim 1, as described above.

Further, Ritter teaches *a mobile communication terminal, comprising a subscriber identity module, wherein said mobile communication terminal is used as an authentication token for an access control system* (Page 11 Lines 20-29; the chipcard in a mobile station can be loaded with an electronic key to authenticate the user to access control device and system).

Regarding to Claim 17, Ritter teaches all of the limitations of Claim 1, as described above.

Further, Ritter teaches *a mobile communication terminal, comprising a subscriber identity module, wherein said mobile communication terminal is used as an authentication token for a mobile commerce system* (Page 10 Lines 9-24 and Page 11 Lines 20-29; direct communication between chipcard in a mobile station and external device with the aid of coil or antenna can make loading money to and from mobile station possible).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

Determining the scope and contents of the prior art.

2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 7, 9, 10, 18 and 19 are rejected under 35 U.S.C. 103(a) as been unpatentable over Ritter, in view of Hussmann (US 2003/0218532 A1).

Regarding to Claim 7, Ritter teaches all of the limitations of Claim 1, as described above.

Further, Ritter teaches *said interrogatable transponder is arranged to transmit a RF signal coded with said identification data* (Page 4 Lines 25-28, Page 6 Lines 17-33 and Page 11 Lines 19-31; direct 2-way

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communication is established between the chipcard and external device with the aid of antenna to exchange electronic key stored in the memory).

Ritter may not specifically teach *when interrogated by an external interrogating RF device*. In an analogous art, Hussmann teaches the interrogating apparatus transmits a request radio signal, emitted as an electromagnetic field, picked up by transponder that causes the transponder to transmit a reply signal comprising identification data through antenna (Paragraph 0029). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to teach *when interrogated by an external interrogating RF device* because it would preserve battery by only responding when requested.

Regarding to Claim 9, Ritter teaches all of the limitations of Claim 8, as described above.

Ritter may specifically teach *said transponder is a separate device, comprising a processing device, a memory device and an I/O device connected to an antenna*. In an analogous art, Hussmann teaches the active RFID transponder is a separate device that comprises an antenna, an integrated circuit and memory (Figure 2 and Paragraph 0029). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to teach *said transponder is a separate device, comprising a processing device, a memory device and an I/O device connected to an antenna* because it provides further mobility of the transponder and that it has been held that rearranging parts of an invention involves only routine skill in the art.

Regarding to Claim 10, the combination of Ritter and Hussmann teaches all of the limitations of Claim 9, as described above.

Ritter may not specifically teach *said transponder comprises an antenna, and wherein further RFID transponder functionality is implemented by means of the processing device and the memory device included in said subscriber identity module*. In an analogous art, Hussmann teaches the active RFID transponder comprises an antenna (Paragraph 0029) and the SIM is characterized by means of processing device and memory device for writing user-specific information into the transponder memory unit (Paragraphs 0009 and 0011). Therefore, it would have been obvious to one of ordinary skill in the art

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at the time of invention to teach *said transponder comprises an antenna, and wherein further RFID transponder functionality is implemented by means of the processing device and the memory device included in said subscriber identity module* because it provides mobility and effective way of configure the chip and cost effective since it provides value-added service suitable for the user that can be produced at very low cost.

Regarding to Claim 18, Ritter teaches *method for execution by a subscriber identity module, for the purpose of providing secure data communication between the subscriber identity module and an external interrogating device* (Page 6 Lines 17-30 and Page 11 Lines 19-31; the chipcard stores user identification and exchange the information with external device), *said subscriber identity module comprising a processing device* (Figure 2 and Page 1 Lines 22-26 and Page 6 Lines 1-16; microcontroller and data processing zone), *a memory device containing a private key* (Figure 2 and Page 1 Lines 22-26, Page 6 Lines 1-16 and Page 11 Lines 19-31; memory zone for storing electronic key), *an I/O device* (Figure 2 and Page 1 Lines 22-26 and Page 6 Lines 1-16; contact area for communication between SIM and mobile station), *and a wireless communication device which is connected to an antenna included in said subscriber identity module* (Figure 2 and Page 6 Lines 17-33; the SIM has a integrated circuit responsible for the direct communication with an external device via coil or antenna), *the wireless communication device being an interrogatable transponder* (Figure 2 and Page 6 Lines 17-33; the SIM has a integrated circuit responsible for the direct communication with an external device via coil or antenna), *operatively enabled or disabled, controlled by a signal provided by the mobile communication terminal via said I/O device* (Figure 2 and Page 6 Lines 1-16 and Page 9 Lines 5-11; the mobile station sends instruction from keyboard to chipcard via contact area, and chipcard then communicates the instruction to external device via coil or antenna),

said method comprising the steps of

transmitting identification data (Page 4 Lines 25-28, Page 6 Lines 17-33 and Page 11 Lines 19-31; direct 2-way communication is established between the chipcard and external device with the aid of antenna to exchange electronic key stored in the memory).

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Ritter may not specifically teach *upon an interrogation by the external interrogating device, receiving an encrypted message from the external communication device, said message being encrypted with a public key associated with said identification data, decrypting said encrypted message using said private key and using the decrypted message as a shared key to encrypt further data communication between the subscriber identity module and the external interrogating device*. In an analogous art, Hussmann teaches the interrogating apparatus transmits a request radio signal, emitted as an electromagnetic field, picked up by transponder that causes the transponder to transmit a reply signal comprising identification data through antenna (Paragraph 0029). Further, Hussmann teaches the interrogating apparatus emits a signal comprising a RAND-number (Paragraph 0042), decrypt the message based on Ki and RAND using algorithm A3 (Paragraph 0041), and the transponder and the interrogating apparatus transmits signals containing SRES (Paragraph 0042). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to teach *upon an interrogation by the external interrogating device, receiving an encrypted message from the external communication device, said message being encrypted with a public key associated with said identification data, decrypting said encrypted message using said private key and using the decrypted message as a shared key to encrypt further data communication between the subscriber identity module and the external interrogating device* because it conserves battery power and provides secured data communication between devices.

Regarding to Claim 19, the combination of Ritter and Hussmann teaches all of the limitations of Claim 18, as described above.

Ritter may not specifically teach *said public key is provided by said external interrogating device by searching a database in order to match said identification with the corresponding public key*. In an analogous art, Hussmann teaches interrogating apparatus obtains a RAND by first obtaining the user identity through database (Paragraphs 0044-0046). Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to teach *said public key is provided by said external*

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interrogating device by searching a database in order to match said identification with the corresponding public key because it provides secured data communication between devices.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jing (Kristen) Gao whose telephone number is (571)270-7226. The examiner can normally be reached on Monday-Friday, 09:00am - 5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on (571) 272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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| /George Eng/ Supervisory Patent Examiner, Art Unit 2617 | /Jing (Kristen) Gao/ Examiner, Art Unit 2617 10/22/2010 |
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